

### **REMARKS**

Favorable consideration and allowance of the present application is respectfully requested.

Claims 42-68, including independent claims 42 and 59, are currently pending in the present application. Independent claim 42, for instance, is directed to a medical packaging substrate comprising a paper-based web. The paper-based web is impregnated with a saturant comprising a latex polymer emulsion. The latex polymer emulsion comprises a polyacrylate having a glass transition temperature of -20°C or less. The saturant is present at an add-on level of from about 20 to about 80 dry parts per 100 dry parts of fiber in the paper-based web. Further, the medical packaging substrate exhibits a percent bacterial filtration efficiency of at least about 95%.

In the Office Action, claims 42-68 were rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,887,537, either alone or in combination with U.S. Patent No. 5,191,734. Without commenting on the propriety of this rejection, Applicants submit herewith a Terminal Disclaimer pursuant to 37 C.F.R. § 1.321 to overcome this rejection.

Also in the Office Action, claims 42-44, 46-60, and 62-68 were rejected under 35 § 103 in view of U.S. Patent No. 5,191,734 to Weber, et al. Weber, et al. discloses a biodegradable latex web material including a web of cellulose fibers saturated with a latex composition. The latex composition comprises a polyacrylate, nitrile rubber, natural rubber or combinations thereof.

As previously pointed out, however, Weber, et al. does not disclose a polyacrylate having a *glass transition temperature of -20 °C or less* as required by the present claims. The Office Action cites the disclosure of the nitrile rubber Hycar ® 1570x50 (shown in Table II), which has a glass transition temperature of -48 °C, according to U.S. Patent No. 5,370,132, as providing disclosure of a latex binder having a glass transition temperature of less than -20 °C. However, this disclosure is directed to a nitrile rubber, which as one of ordinary skill in the art would recognize is different than the polyacrylate required by independent claims 42 and 59. Applicants respectfully submit that the disclosure of a nitrile rubber having a glass transition temperature of -48 °C would not motivate one of ordinary skill in the art to use a polyacrylate having a glass transition temperature of less than -20 °C.

Weber, et al. only mentions the following polyacrylate synthetic latexes: Hycar® 26083, 26084, 26120, 26106, 26322, and Rhoplex® B-15, HA-8, HA-12, and NW-1715. As pointed out in the previous Response filed on Feb. 8, 2006, these polyacrylate synthetic latexes have glass transition temperatures of -15 °C or higher, according to the references. Clearly then, Weber, et al. does not disclose a polyacrylate latex having the claimed glass transition temperature.

In fact, the Office Action admits that Weber, et al. “does not specifically disclose the use of a polyacrylate latex having a glass transition temperature of -20 °C or lower.” Thus, the Office Action cites the paper “Hystretch ® Elastomeric Emulsions,” Noveon, Inc. 2001-2006 for disclosing an anionic polyacrylate latex emulsion designated V-43 having a glass transition temperature of -43 °C.

Applicants respectfully submit that one of ordinary skill in the art would not be motivated to use the polyacrylate latex designated Hystretch ® V-43 in the web materials of Weber, et al. Although Weber, et al. discloses that other types of latexes having a glass transition temperature of between  $-50^{\circ}\text{C}$  and  $20^{\circ}\text{C}$ , the only polyacrylate latexes disclosed by Weber, et al. have a glass transition temperature of  $-15^{\circ}\text{C}$  or greater. Weber, et al. discloses only non-polyacrylate latexes, such as a nitrile rubber latex, having a glass transition temperature of less than  $-15^{\circ}\text{C}$ . Thus, one of ordinary skill in the art would not be motivated to use a polyacrylate latex having a glass transition temperature of less than  $-15^{\circ}\text{C}$ .

Furthermore, Applicants respectfully submit that the only motivation to use the Hystretch ® V-43 improperly stems from the present application. Without the disclosure of the present specification, one of ordinary skill in the art would not be motivated to use the polyacrylate latex designated Hystretch ® V-43. The polyacrylate latex designated Hystretch ® V-43 is one of the particular polyacrylate latexes disclosed by the present application. See, e.g., pg. 8, lines 15-28. As described in the specification, such polyacrylates exhibit the most desirable bacterial filtration efficiencies in comparison to other binder systems. See, e.g., pg. 16, lines 18-22.

Applicants note that it is improper to use a patent applicant's own specification to provide the only suggestion for modifying the prior art. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make

the modification obvious unless the prior art suggested the desirability of the modification. Plainly, the Examiner's only incentive or motivation for so modifying Weber, et al. in the manner suggested in the Office Action results from using Applicants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art, which is improper under 35 U.S.C. § 103. Accordingly, it is respectfully submitted that any such modification of the cited references relies on the impermissible use of hindsight, which cannot be successfully used to support a *prima facie* case of obviousness.

In any event, Weber, et al. is directed to a material for use in agricultural mulch and row covers, bags, outer covers for personal care products (e.g., diapers, feminine pads, training pants, incontinence products, and wound dressings), surgical drapes, and gowns. As previously pointed out, Weber, et al. fails to disclose the claimed "medical packaging substrate" and "Bacterial Filtration Efficiency." Nevertheless, the Examiner continues to give no weight to the preamble.

When the preamble recites a limitation in the context of the entire claim, however, it should be read as if in the balance of the claim. (*M.P.E.P.* § 2111.02). In this case, the phrase "medical packaging substrate" acts as a limitation when read in the context of the present claims. Moreover, upon review of the entirety of the present application, it is evident that such a medical packaging substrate is what the present inventors actually invented and intended to encompass in the present claims. Thus, for at least these reasons, Applicants respectfully submit that the present claims patentably define over Weber, et al.

Weber, et al. also fails to expressly disclose the claimed bacterial filtration efficiency. Nevertheless, the Examiner previously asserted that the value is “inherent.” To establish inherency, however, the evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing *may* occur or be present in the reference is not sufficient. Simply stated, inherency may not be established by probabilities or possibilities.

In this case, the basis for the inherency rejection was said to hinge on the fact that the product and process of the claims and Weber, et al. are the same. However, Weber, et al. does *not* disclose the same materials used in the present claims, e.g., a polyacrylate latex with a glass transition temperature of -20°C or less. In fact, the Examiner previously conceded that “the basis for inherency could *not* be established” if a reference failed to disclose the claimed glass transition temperature. (Office Action of 02/24/05, pp. 3-4) (Emphasis added). In any event, Applicants note that a variety of other aspects of the claimed medical packaging substrate may influence its % BFE, e.g., the add-on level, the type of web, and so forth. In view of the wide variety of parameters that may be altered to influence % BFE, there is simply no indication that Weber, et al. would necessarily result in the claimed % BFE. Thus, for at least the reasons set forth above, Applicants respectfully submit that Weber, et al. does not disclose the claimed % BFE.

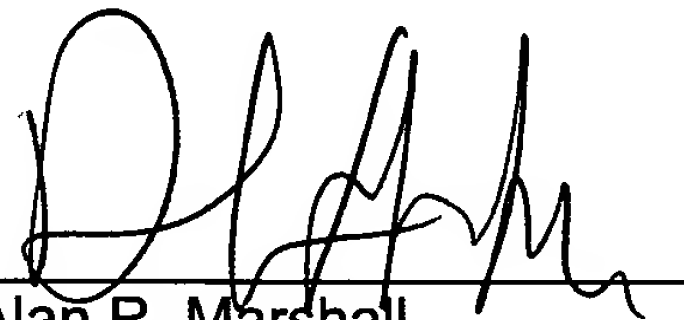
Thus, for at least the reasons set forth above, it is believed that the present application is in complete condition for allowance and favorable action, therefore, is

respectfully requested. Examiner Vo is invited and encouraged to telephone the undersigned, however, should any issues remain after consideration of this Response.

Please charge any additional fees required by this Response to Deposit Account No. 04-1403.

Respectfully submitted,

DORITY & MANNING, P.A.

A handwritten signature in black ink, appearing to read 'Alan R. Marshall', written over a horizontal line.

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